REMARKS

This Response is submitted in reply to the Office Action dated March 30, 2004. Claims 12-29 are pending in the patent application. Claims 12, 14, 17, 18, 20, 23, 24, 26 and 29 have been amended for clarification purposes and not for any reasons of patentability. The Patent Office acknowledges that claims 18-23 are directed to allowable subject matter. Applicants respectfully submit, for the reasons set forth below, that the rejections have been overcome or are improper. Accordingly, Applicants respectfully request reconsideration of the patentability of claims 12-17 and 24-29.

Claims 12-14 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 5,685,000 to Cox, Jr. ("*Cox Jr.*") in view of U.S. Patent No. 5,754,939 to Herz et al. ("*Herz*"). Claims 15-16 and 27-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cox Jr. in view of U.S. Patent No. 5,916,024 to Von Kohorn ("*Von Kohorn*"). Additionally, claims 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cox Jr.* in view of U.S. Patent No. 6,477,509 to Hammons et al. ("*Hammons*").

Claims 12-14 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable or *Cox Jr.* in view of *Herz*. Applicants respectfully submit that the combination of *Cox Jr.* and *Herz* does not disclose, teach or suggest all of the elements of claims 12-14 and 24-26.

A person of ordinary skill in the art would not be motivated to combine *Cox Jr.* and *Herz* to achieve the claimed invention. In the Office Action, the Patent Office cited the Federal Circuit case of *Ruiz v. A.B. Chance* to support the combination of *Cox Jr.* and *Herz* to achieve the claimed invention. Specifically, the Patent Office stated that in *Ruiz* the Federal Circuit Court stated that "a court or examiner may find the motivation to combine references in the nature of the problem to be solved." (See the Office Action on page 4; see *Ruiz v. AB Chance Co.*, U.S. P.Q 2d 1686 (Fed. Cir. 2004)). The Patent Office therefore stated that both *Cox, Jr.* and *Herz* are combinable to achieve the claimed invention based on the nature of the problem to be solved by the claimed invention. Applicants respectfully disagree with the interpretation of *Ruiz* by the Patent Office based on the facts presented in *Ruiz*.

In *Ruiz*, the Federal Circuit stated that "the motivation to combine the teachings in the prior art may come from the nature of a problem to be solved, leaving inventors to look to references relating to possible solutions to that problem." The Federal Circuit went on to support

the District Court's decision that there was a motivation to combine the teachings in two prior art references to invalidate a patent because the prior art references address the exact same problem as the patent. Contrary to the facts stated in *Ruiz*, Applicants respectfully submit that a person of ordinary skill in art would not combine *Cox Jr.* and *Herz* because, at the least, *Cox Jr.* does not address the same problem as the claimed invention.

The claimed invention is directed to an information processing apparatus and method which simplifies internet searches performed by users based on the interests and tastes of the user. Many people use the internet to search for information. In particular, people use search engines which utilize key words to search for information desired by a user. The search results returned by search engines are typically lengthy and require the user to sort through the information to attempt to find the information desired by the user. One solution to minimize the time spent by the user sorting through the information returned by the search engine is to prepare a user profile before performing a search where the user profile includes the interests and tastes of the user. The user profile, however, requires that the user use a key port or other input device such as a mouse, to enter the information that forms a user profile. (See the Specification at page 31, lines 107). Thus, a burden is still placed on the user to spend their time entering all the information necessary to create the profile. The claimed invention solves the above problems for searching for information, such as information on the internet, by enabling the user to speak to a speech recognizing device which recognizes the speech of the user and collects information based on topics included in the speech of the user. Therefore, the claimed invention enables the user to search for specific information on the internet or other data network without placing a heavy burden on the user to input and search for the information and then sort through all of the returned search results.

Cox Jr. solves a problem which is very different from the problem addressed by the claimed invention. *Cox Jr.* is directed to a method for providing a linguistically competent dialogue with a computerized service representative which simplifies task modeling for dialogue systems. The method initially models a desired task as a plurality of database slots. (See, col. 1, lines 43 to 56). Each user utterance or speech causes the database slots to be filled with recognized values. Subsequently, a responsive utterance is generated according to a predetermined set of condition-action rules based on the combinations of the filled slot values.

Cox Jr. attempts to solve the problems of existing spoken dialogue systems and methods which are highly complex and difficult to implement in practice because of varying speech dialects and intonations of users. (See Col. 1, lines 14-35.) *Cox Jr.*, therefore, is directed to developing a simpler approach as opposed to the described complex approach. *Cox Jr.* is not concerned with analyzing speech to collect user information based on the number of times that a topic is included in the speech where the information is collected based on that count and number. Instead, *Cox Jr.* is concerned with the quality of the dialogue recognition itself.

Accordingly, *Cox Jr.* does not address the same or even a similar problem as the claimed invention. Therefore, based on the problem to be solved by the claimed invention, a person of ordinary skill in the art would not be motivated to combine *Cox Jr.* and *Herz* where *Cox Jr.* does not address or even discuss the issue of simplifying the search for and collection of information desired by a user.

Even if *Cox Jr.* and *Herz* were combined, neither reference when taken alone or in combination, disclose, teach or suggest the elements of the claimed invention. As described above, *Cox Jr.* describes a method for providing linguistically competent dialogue with a computerized service representative which recognizes utterances or speech by a user and responds with dialog based on those utterances or speech. However, as stated by the Patent Office, *Cox Jr.* does not teach a "matter of accounting or statistical operations" such as the claim element of counting the number of times the topic appears or is mentioned in a speech of a user. (See the Office Action, page 6, lines 16 to 23). The Patent Office, therefore, relies on *Herz* to remedy the deficiencies of *Cox Jr.*

Herz discloses a system for the generation of user profiles for a system for customized electronic identification of desirable objects. The system constructs a target profile and target profile summary for each user. However, *Herz* does not disclose, teach or suggest a speech recognition device used for searching for information on the internet or the like based on the number of times or appearances of a particular topic is spoken by or inputted by a customer. Also, *Herz* does not disclose, teach or suggest creating dialogue employing any type of speech recognition devices. Therefore, a person of ordinary skill in the art, would not be motivated to combine the method for providing a linguistically competent dialogue with a computerized service representative as described by *Cox, Jr.* with the system for generation of user profiles

described by *Herz* where there is no teaching or suggestion in either reference to make such a combination.

Accordingly, Applicant respectfully submits that the combination of *Cox Jr.* and *Herz* does not disclose, teach or suggest the elements of the claimed invention. Therefore, claims 12 and 24 and claims 13 to 14 and 25 to 26, which depend from claims 12 and 24, respectively, are each patentably distinguished from the combination of *Cox Jr.* and *Herz* and are in condition for allowance.

Claims 15, 16, 27 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cox Jr.* in view of *Von Kohorn*. Claims 15 and 16 depend from claim 12 and claims 27 to 28 depend from claim 24. Therefore, Applicants respectfully submit that claims 15, 16, 27 and 28 are allowable for at least the reasons set forth above with respect to independent claims 12 and 24 because the combination of *Cox Jr.* and *Von Kohorn* does not disclose, teach or suggest the novel elements of claims 15, 16, 27 and 28 in combination with the novel elements of independent claims 12 and 24, respectively. For these reasons, claims 15, 16, 27 and 28 are patentably distinguished over the combination of *Cox Jr.* and *Von Kohorn* and are in condition for allowance.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cox Jr.* in view of *Hammons*. Claims 17 and 29 depend from independent claims 12 and 24, respectively. Therefore, Applicants respectfully submit that claims 17 and 29 are allowable for at least the reasons set forth above with respect to independent claims 12 and 24 because the combination of *Cox Jr.* and *Hammons* does not disclose, teach of suggest the novel elements of claims 17 and 29 in combination with the novel elements of independent claims 12 and 24, respectively. For these reasons, claims 17 and 29 are patentably distinguished over the combination of *Cox Jr.* and *Hammons* and are in condition for allowance.

Claims 18-23 have been deemed allowable. Therefore, Applicants respectfully submit that, for the above reasons, all of the claims 12-29 in the present application are in condition for allowance and respectfully solicit an early allowance of these claims.

No fees are due. If any other fees are due in connection with this application as a whole, the Patent Office is authorized to deduct such fees from deposit account 02-1818. If such a withdrawal is made, please indicate the attorney docket number (112857-246) on the account statement.

Respectfully submitted,

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